

REMARKS

Claims 1-21 are all of the claims presently pending in the application. New claim 21 has been added. Claims 1-20 stand rejected under 35 USC §101 as allegedly directed toward non-statutory subject matter.

Applicants gratefully acknowledge the Examiner's indication that, if the non-statutory rejection is overcome, claims 1-20 would be allowed.

Applicants respectfully traverse this remaining rejection.

I. THE CLAIMED INVENTION

In one aspect and as described in the specification and defined by, for example, claim 5, the present invention is directed to an apparatus for calculating a global optimization to a minimum-maximum problem. A first calculator provides a plurality of minimum values and a second calculator locates a global optimum value, given this plurality of minimum values.

Conventional techniques for arriving at a global optimum, as described beginning at line 19 of page 2 of the specification, are NP-hard and difficult to resolve in a reasonable time. These conventional methods include Simulated Annealing, Genetic Algorithm, or other Monte Carlo type techniques.

The claimed invention, on the other hand, provides a method to find a global optimum to a minimum-maximum problem by first calculating a plurality of minimum values and then using these minimum values to locate the global optimum value.

II. THE 35 USC §101 REJECTION

Claims 1-20 stand rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. As best understood, the Examiner considers that the present invention fails to provide a "useful, concrete and tangible result", the test confirmed in *State Street* and *AT&T* as appropriate for software-related patents.

As best understood, the Examiner is concerned about having the result conveyed to a real world environment via a display or storage. Although Applicants do not believe that such claim modification is necessary, independent claims have been amended to attempt to expedite prosecution.

Moreover, Applicants again respectfully submit that even the originally-worded claims satisfy the description of the new Guidelines, as follows. First, the method claims 1-4 are clearly describing a process being executed on a computer. As such, Applicants submit that even the USPTO would have to admit that the process is inherently concrete and tangible, since, otherwise, the USPTO would not themselves be using computer tools. Relative to the issue of usefulness, the present invention was originally developed as a tool to determine an optimal design of three-dimensional parts for manufacturing, as constrained by prescribed tolerances. Applicants submit that this result is indeed a real-world, useful result. Therefore, Applicants submit that method claims 1-4 are indeed directed toward statutory subject matter.

Applicants respectfully submit that the Examiner's position is due to confusion about the requirement for "useful, tangible and concrete", since the evaluation is intended as directed to the claimed invention as a whole. That is, Applicants submit that the evaluation is not directed to determining whether the independent claims recite some sort of a "real-world" step.

Relative to apparatus claims 5-7, system claim 8, and claims 14-20, Applicants submit

that these claims are allowable either because of their definition as hardware and/or software systems or, if viewed from the aspect of software modules, because one of ordinary skill in the art would consider that the description clearly indicates that the claimed invention is directed to modules in control of a digital machine. Relative to claim 13, Applicants submit that this claim is directed to a business method based upon using the method of the present invention on a computer. Finally, relative to claims 9-12, Applicants submit that these claims are Beauregard claims, meaning that they are directed to media that tangibly embody the machine-readable instructions and are clearly statutory subject matter.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-21, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/773,261
Docket No. YOR92000256US1

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



Date: May 8, 2007

Frederick E. Cooperrider
Registration No. 36,769

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254